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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,098	02/05/2004	Robert J. Monson	3114.02US02	3282
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BROOKS & CAMERON, PLLC 1221 NICOLLET MALL #500 MINNEAPOLIS, MN 55403				
EXAMINER HUGHES, JAMES P				
ART UNIT			PAPER NUMBER	
2883				

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,098	<b>Applicant(s)</b> MONSON ET AL.	
	<b>Examiner</b> James P. Hughes	<b>Art Unit</b> 2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed on August 25, 2006 have been fully considered but they are not persuasive. Applicant argues generally that the instant application is not an obvious variant of U.S. Pat. No. 7,035,521 and 6,902,239 based on the disclosed inventions rather than the claimed inventions. Applicant argues that the inventions are distinct because applicant chose to file for protection separately. Respectfully, applicant unpersuasively states that the “rocker plate is not . . . a type of rotating clamp as described in the references cited” (page 7) without any further explanation. Respectfully, these arguments are not persuasive because inventions are differentiated by their claims rather than their disclosures.

2. Applicant argues that Dudek does not teach a “means for securing the optoelectronic device (e.g. 12) against the electronic substrate (e.g. 22)” (page 7) because “the Dudek reference appears to describe an integration of an optoelectronic device, but it does not appear to recite an electronic substrate . . .” (page 8). Respectfully, this argument is not persuasive because Dudek teaches that the electronic substrate—or VCSEL plate—(22), which is mounted to the VCSEL array (12) and photodiode (26). See e.g., Col. 4, ll. 45-55 and Col. 5, ll. 57 – Col. 6, ll. 32.

***Claim Objections***

3. Claim 19 is objected to because it is missing a period.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Dudek et al. (6,767,141). Dudek et al. (6,767,141), hereinafter referred to as “Dukek”, teaches an optoelectronic device integration tool for connecting an optoelectronic device to an electronic substrate of a parallel optical transceiver package, the tool comprising: means for retaining the optoelectronic device (e.g. 12) within a mounting frame; means for securing the optoelectronic device (12) to the parallel optical transceiver package (e.g. 14) and means for securing the optoelectronic device (12) against the electronic substrate (e.g. 22) during the connection process. (See Col. 3, ll. 32 – Col. 4, ll. 65 and Fig. 2)

It is noted that the recited limitation of “during the connection process” (line 8) has not been given significant patentable weight as it comprises functional language and claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114 and In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not

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identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 19 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,035,521. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the 521' patent claims "A parallel optical transceiver package assembly tool for integration of an optoelectronic device, said tool comprising: a clamp base connected to the parallel optical transceiver package; a spring clamp frame hingedly connected to the clamp base allowing for rotational engagement with the optoelectronic device; and a clamp connected to the spring clamp frame for engaging the optoelectronic device." (Claim 1)

Regarding, claim 19; the 521' patent claims integration of an optoelectronic device, it does not recited an electronic substrate secured against the optoelectronic device. However, as substrates are notoriously well known in the art of optoelectronic devices, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ an electronic substrate with the integration of the optoelectronic

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device of the 521' patent to give support and/or electrical connections to the optoelectronic device.

6. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 7,035,521 in view of Sauter et al. (6,056,448). Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 7,035,521. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application recitation to a “a *rocker* plate clamp frame *pivotally* connected” [emphasis added] (line 5) would have been an obvious variant at the time of the invention to one of ordinary skill in the art of the 521' patent's recitation of “a spring clamp *hingedly* connected to the clamp base” [emphasis added] (line 6 of claim 1) because they would provide functional equivalents.

Additionally, the 521' patent does not explicitly recite an MT connector or a VCSEL laser as part of the integrated optoelectronic device. However, as MT connectors and VCSEL lasers are well known in the art of integrated optoelectronic devices as taught for example by (Sauter), it would have been obvious to one of ordinary skill in the art at the time of the invention that MT connector and/or a VCSEL could be employed in the device of the 521' patent to allow the integrated optoelectronic device to be integrated into other standard communication systems.

7. Claim 19 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,902,329 in view of

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Sauter et al. (6,056,448). Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application recitation to a “a *rocker* plate clamp frame *pivotally* connected” [emphasis added] (line 5) would have been an obvious variant at the time of the invention to one of ordinary skill in the art of the 329’ patent’s recitation of “means for *rotating* the optoelectronic device relative to the electronic interface substrate” [emphasis added] (lines 12-13 of claim 6) because they would provide functional equivalents.

8. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-13 of U.S. Patent No. 6,902,329 in view of Sauter et al. (6,056,448). Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application recitation to a “a *rocker* plate clamp frame *pivotally* connected” [emphasis added] (line 5) would have been an obvious variant at the time of the invention to one of ordinary skill in the art of the 329’ patent’s recitation of “means for *rotating* the optoelectronic device relative to the electronic interface substrate” [emphasis added] (lines 12-13 of claim 6) because they would provide functional equivalents.

Additionally, the 329’ patent does not explicitly recite an MT connector or a VCSEL laser as part of the integrated optoelectronic device. However, as MT connectors and VCSEL lasers are well known in the art of integrated optoelectronic devices as taught for example by (Sauter), it would have been obvious to one of ordinary skill in the art at the time of the invention that MT connector and/or a VCSEL could be employed in the

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device of the 521' patent to allow the integrated optoelectronic device to be integrated into other standard communication systems.

***Allowable Subject Matter***

9. Provided that the appropriate terminal disclaimers are filed, claims 1-8 are allowable as indicated in the previous action.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

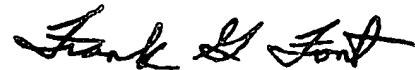
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James P. Hughes whose telephone number is 571-272-2474. The examiner can normally be reached on Monday - Friday 9am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James P. Hughes  
Patent Examiner  
Art Unit 2883



Frank G. Font  
Supervisory Patent Examiner  
Technology Center 2800